

Serial No.: 10/065,285  
Attorney Docket No.: F-560

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CENTRAL FAX CENTER

Patent

**JUN 22 2006****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of: ) Attorney Docket No.: F-560  
John F. Braun, et al. ) Customer No.: 00919  
Serial No.: 10/065,285 ) Examiner: Schaffer, Jonathan C.  
Filed: September 30, 2002 ) Group Art Unit: 2621  
Confirmation # 5700 ) Date: June 22, 2006

Title: METHOD AND SYSTEM FOR IDENTIFYING A PAPER FORM USING  
A DIGITAL PEN

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MAIL STOP AF  
Commissioner for Patents  
PO BOX 1450  
Alexandria, Virginia 22313-1450

Sir:

This communication is submitted in response to the March 22, 2006 Final Office Action ("Office Action"). A Notice of appeal is filed concurrently herewith. Consideration of the enclosed remarks is respectfully requested.

The following sections are enclosed:

1. Statement in Support of Pre-Appeal Brief Request For Review

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on June 22, 2006 (Date of Transmission).

George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)

 (Signature) June 22, 2006 (Date)

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**Statement in Support of Pre-Appeal Brief Request For Review**

Claims 1-15 are pending in the Application. Applicants had amended claims 1, 3, 9, 11 and 14 and the Examiner finally rejected the claims based in part upon newly cited reference U.S. Patent Number 5,974,177 to Krtolica ("Krtolica '177").

Applicants respectfully requests that the panel find that the application is in condition for allowance on the existing claims.

**Rejections under 35 USC § 103(a)**

In section 5 of the Office Action, the Examiner rejected Claims 1-15 under 35 U.S.C. 102(e) as allegedly rendered obvious by U.S. Patent Application Publication No. 2002/0067854 A1 by Reintjes, et al. ("Reintjes '854") in view of U.S. Patent Number 5,974,177 to Krtolica ("Krtolica '177").

Applicants respectfully traverse the rejection and urge the panel to find the claims allowable over the cited references for at least the following reasons.

Applicants respectfully submit that the references are not properly combined. Reintjes '854 describes only systems for distinguishing form types by comparing templates of input field locations on the form. It is impermissible hindsight to suggest that one of skill in the art would look to any character tracing teachings since the only possible relevant factor would be field locations. See Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561 (Fed. Cir. 1987).

Furthermore, the suggested combination would be impermissible because it would render the primary reference inoperable. See In re Gordon, 733 F.2d 900 (Fed. Cir. 1984). Reintjes '854 describes only systems that distinguish form types based upon field location. To modify Reintjes '854 with a input field content discrimination system would be inoperable with the input field location template discrimination system described. In fact, with regard to at least claims 6 and 14,

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Reintjes '854 could not function if the identifying characters were in the same location since it relies on differences in input field locations to identify a form type.

Furthermore, Applicants respectfully submit that the Examiner has misstated the teachings of the Krtolica '177 reference.

It is clear from a review of FIG. 4 and the corresponding text at columns 9 and 10, that the Krtolica '177 reference in no way teaches tracing over characters as suggested by the Examiner. The reference symbols are printed in the reference symbol region 48R and the user does not write in that area. The user writes in the hand entry area 48H that includes input fields designated as hand entry areas but that does not include characters or symbols that are traced over by the user.

Furthermore, if the Examiner is taking the interpretation that the box identifying the filed is a character to be traced over, such an interpretation is improper and clearly at odds with the teaching of the cited reference and the instant specification. The user in Krtolica '177 would not trace over the entire "guide constraints" as that would result in non-sense input. Furthermore, tracing over each such "box" with an interior "X" and "+" symbol could clearly not be a form identifier character as claimed in that such input could not vary. The reference clearly describes reference symbols 48R "character of common alpha numeric fonts" (see col. 9, l. 56) that are not traced over and "guide constraints" 48H that plainly differ from reference symbols (defined as characters by the reference itself) according to any fair interpretation and any fair reading of the reference.

Accordingly, the reference is not properly applied or combined and the Examiner has failed to put forth a prima facie rejection. Applicants respectfully request that the panel find that the claims are allowable over the cited references.

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Accordingly, Applicants respectfully request that the panel find that the invention as presently claimed in claims 1-15 is patentable and in condition for allowance.

Respectfully submitted,



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